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REMARKS

Reconsideration of the present application is respectfully requested. Claims 1 to 13 are currently pending, and no claims have been amended.

The Final Office Action mailed February 28, 2003 addressed claims 1 to 13. Claims 1 to 13 were rejected.

Claims 1 to 5, 9 to 11 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Horiuchi et al. The Examiner stated that Nesbitt discloses the claimed invention with the exception of the particular materials utilized, but one of ordinary skill in the art would, in view of Nesbitt's disclosure, recognize that other known materials could have been utilized in the invention so long as the cover comprised a harder inner layer overlaid by a softer outer layer. The Examiner further stated that as disclosed by Horiuchi the use of high acid ionomers is known in the art. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to utilize the known materials disclosed by Horiuchi for their recognized advantages as noted by Horiuchi in the relationship suggested by Nesbitt to achieve a ball with such advantages.

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. Nesbitt, the primary reference, discloses a golf ball comprising a core and a multi-layer cover. The inner cover layer comprises a hard, high flexural modulus ionomer, and the outer cover layer comprises a soft, low flexural modulus ionomer. Nesbitt uses as examples Surlyn® 1605 and 1855 ionomers, high and low flexural modulus ionomers respectively. Nesbitt does not disclose a multi-layer cover where the inner cover layer comprises a high acid ionomer containing at least 16% by weight of an alpha, beta-unsaturated carboxylic acid and the outer cover layer comprises a relatively soft polymeric material selected from the group consisting of low flexural modulus ionomer resins and non-ionomeric elastomers.

Horiuchi is directed to a golf ball having a single layer cover comprising at least 20% of a carboxyl-rich ionomer resin prepared by neutralizing 15 to 80 mol % of carboxylic acid groups of an olefinic copolymer containing 16 to 30% by weight of an alpha, beta-ethylenic unsaturated carboxylic acid with monovalent or divalent metal

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ions. Horiuchi teaches using high acid ionomers in an outer cover layer rather than an inner cover layer. Applicants respectfully submit that there is no motivation, teaching or suggestion in Horiuchi to use high acid ionomer resins in an inner cover layer. Instead, the only specific teaching in Horiuchi shows high acid ionomers in golf ball outer covers of two piece golf balls or wound balls having a single, outer cover layer. Contrary to the Examiner's assertions, the use of high acid ionomers is not known in the art; instead, it is only known in the art to use high acid ionomers in the outer cover layer or in a single cover layer, as shown in Higuchi.

Since, as discussed above, the primary reference, Nesbitt, is deficient because it does not disclose a golf ball having a multi-layer cover, wherein the inner cover layer comprises a high acid ionomer containing at least 16% by weight of an alpha, beta-unsaturated carboxylic acid and the outer cover layer comprises a relatively soft polymeric material selected from the group consisting of low flexural modulus ionomer resins and non-ionomeric elastomers, the addition of Horiuchi as a secondary reference does not cure this deficiency. Applicant respectfully submits that even if Horiuchi is combined with Nesbitt, Horiuchi is not directed to a golf ball having a high acid ionomer in the inner cover layer. Therefore, the resulting product would contain a high acid ionomer resin in the single or outer cover layer.

Furthermore, Applicant respectfully submits that a prior art patent, such as Nesbitt or Horiuchi, must be considered as a whole, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly suggests to one skilled in the art. Applicant respectfully submits that the Examiner is picking and choosing cover materials from prior art patents in an attempt to recreate Applicant's invention, and one skilled in the art would not select the cover materials the Examiner has selected. Applicant respectfully submits that the Examiner has not shown the motivation, teaching or suggestion to combine Horiuchi with Nesbitt, and the only teaching is found in Applicant's own disclosure. The use of Applicant's disclosure as prior art is not permissible.

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For at least these reasons, Applicant respectfully submits that claims 1 to 5, 9 to 11 and 13 are not obvious under 35 U.S.C. § 103(a) over Nesbitt in view of Horiuchi et al. Applicant therefore respectfully requests that the rejection of claims 1 to 5, 9 to 11 and 13 under 35 U.S.C. § 103(a) as obvious over Nesbitt in view of Horiuchi be reconsidered and withdrawn.

Claims 6 to 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Horiuchi as applied to claim 1, and further in view of Sullivan '814. The Examiner stated that Nesbitt does not suggest his outer cover as being a blend of hard and soft ionomer, but blends of hard and soft ionomer are known to provide a balance of distance, spin, and durability not obtainable previously. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to have used a blend of hard and soft ionomer as Nesbitt's outer cover for the expected results.

Applicant respectfully disagrees with the Examiner and respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Nesbitt in view of Horiuchi does not disclose the invention, with or without an outer cover comprising a blend of hard and soft ionomers, because Nesbitt in view of Horiuchi does not disclose a golf ball with an inner cover layer comprising a high acid ionomer. Therefore, the addition of Sullivan '814 as a secondary reference does not remedy this defect. Furthermore, the Sullivan '814 reference is also directed to a golf ball having a single cover layer, not a multi-layer cover, as disclosed and claimed by the present invention. Therefore, even if the invention was disclosed without an outer cover comprising a blend of hard and soft ionomers, which Applicant submits it is not, there is no motivation, suggestion or teaching to combine Sullivan '814 with Nesbitt to provide a golf ball having an outer cover comprising a blend of hard and soft ionomers.

For at least these reasons, Applicant respectfully submits that claims 6 to 8 and 12 are not obvious under 35 U.S.C. § 103(a) over Nesbitt in view of Horiuchi as applied to claim 1, and further in view of Sullivan. Applicant therefore respectfully requests that the rejection of claims 6 to 8 and 12 under 35 U.S.C. § 103(a) as obvious

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over Nesbitt in view of Horiuchi and further in view of Sullivan be reconsidered and withdrawn.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 13. Applicant respectfully requests allowance of claims 1 to 13, the claims currently pending.

Respectfully submitted,

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